

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims and the following comments.

Claims Status

Claims 1-27 are pending in this Application. No amendments have been made at this time.

Prior Art Rejection Under 102

Claims 17, 18 and 20 have been rejected as being anticipated by Tachibana. The Examiner had taken the position that Tachibana teaches the same force applied during the peeling of the cellulose ester film as recited in the claims. Specifically, the Examiner had cited to Column 10, lines 25-40, where Tachibana teaches a web tension in an amount of 14 Kg/m. The Examiner takes the position that this amount of tensioning overlaps the claimed range of 10 to 80 N/m.

Applicants respectfully disagree because the units of measurement are different. Specifically, the tension measured in the present Invention is 10 to 80 Newtons per meter. Newton is a measurement of force and it is specifically equal to the force on 1 Kg accelerated at one meter per second per second. In other words, a Newton equals the units of $\text{Kg}\cdot\text{m}\cdot\text{sec}^{-2}$. In contrast, the measurement in Tachibana is Kg/m. Thus, the Examiner can appreciate that the units recited in the claims and the units recited in Tachibana are different.

Respectfully, because of the difference in the units of measurement used in Tachibana compared to the claims of the present Invention, Tachibana cannot anticipate the present Invention since not each limitation of Claim 17 has not been met by Tachibana.

Since Claims 18 and 20 ultimately depend upon Claim 17, it is likewise submitted that Tachibana cannot anticipate Claims 18 and 20.

Prior Art Rejection Under 103

The Examiner has put forward three rejections based on a combination of Tachibana with secondary references. Namely,

- (1) Claims 19 and 20 unpatentable over Tachibana in view of Helgerson;
- (2) Claims 15, 16, 26 and 27 unpatentable over Tachibana in view of Goto; and
- (3) Claims 22-25 unpatentable over a combination of Tachibana, Knoop and Roerty.

As the Examiner appreciates, Tachibana is a 102(e) reference only because the present Application has a filing date of January 31, 2002, while Tachibana was published on May 4, 2004 but filed January 27, 2000.

Additionally, it will be noted that Goto is also a 102(e) reference since Goto was published April 4, 2002 but filed July 11, 2001.

Tachibana, on its face, is owned by Konica Corporation while the present Application is also owned by Konica Corporation.

Since both this Application and Tachibana are owned by the same entity and because Tachibana is a 102(e) reference, Applicants hereby avail themselves of 35 USC 103(c) and make the following statement: "the subject matter of Tachibana and the claimed Invention were, at the time the claimed Invention was made, owned by the same person or subject to an obligation of assignment to the same person".

Respectfully, Tachibana is no longer Prior Art under 103.

Additionally, with respect to Goto, Goto is also owned by Konica Corporation and, thus, Applicants also avails themselves of 35 USC 103(c) to remove Goto as Prior Art under 103 by making the following statement: "the subject matter of Goto and the claimed Invention were, at the time the claimed Invention was made, owned by the same person or subject to an obligation of assignment to the same person".

Respectfully, neither Tachibana nor Goto are proper Prior Art under 103. Since Tachibana has used the primary reference for each one of the 103 rejections, Applicants respectfully submit that they have overcome the 103

rejections since they have removed the primary reference. Additionally, with respect to the second 103 rejection, Applicants have removed the secondary reference of Goto and, on this additional basis, submit that the second 103 rejection has also been overcome.


In view of the foregoing, it is respectfully submitted that Applicants have overcome the 103 rejection as put forward in the Office Action.

Conclusion

In view of the foregoing, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. Should any fees or extensions of time or fees be necessary in order to maintain this application in pending condition, appropriate requests are hereby made and authorization is given to debit account #02-2275.

Respectfully submitted,
Lucas & Mercanti, LLP

By:


Donald C. Lucas, Reg. #31,275
(Attorney for Applicants)
475 Park Avenue South
New York, New York 10016
Tel. # (212) 661-8000

DCL/mr